

INITIAL REMARKS

As an initial matter, Appellant did not receive page 8 of Examiner's Answer. PAIR also appears to be missing page 8 as well.

ARGUMENTS

A. Claims 1, 9, 12-16, 18-23, 26-27, and 40-42

Claims 1, 9, 12-16, 18-23, 26-27 and 40-42 are rejected under 35 USC 103(a) as being unpatentable over Aguerre in view of Seidel, allegedly admitted prior art on page 11 of the specification and Albiniano. The thrust of the examiner's rejection focuses on the fact that while the Aguerre patent fails to disclose two important limitations found in independent claims 1 and 42, it would have been obvious to incorporate such limitations into the Aguerre sandal. The first of these limitations (found in independent claims 1 and 42) is that the base section and the strap section are both formed as a part molded from lofted foam material. The second limitation is that the strap section is attached to the base section such that the strap pivots relative to the base section with a frictional force at the contact between the inner portion of the strap section and the outer portion of the rear sole perimeter to thereby maintain the strap section fixed relative to the base section.

As to the limitation that both the base section and the strap section must be constructed of a lofted foam material, the examiner asserts that since the Seidel shoe is constructed of a foam material, "it would have been obvious to one of ordinary skill in the art at the time the invention was made to make all the parts of the footwear of Aguerre '249 from expanded foam material as taught by Seidel '600 for easier and chapter manufacturing of the footwear." Answer, p. 4, lines 2-5. This argument fails for at least two reasons.

First, Seidel does not describe a shoe with any type of heel strap, let alone one constructed of a lofted foam material. Hence, there is clearly no teaching in Seidel to make the Aguerre strap of a lofted foam material. As such, the examiner has failed to present a prima facie case of obviousness for at least this reason.

Second, Aguerre teaches away from making a base section "formed as a first part molded from a first continuous piece of lofted foam material" by disclosing a sandal that is constructed of discrete pieces of multiple materials. As such, the requisite motivation for the specific combination of elements in the cited references is lacking. More specifically, Aguerre teaches a sandal with a base that includes at least three to four discrete materials that are glued or otherwise attached to each other. These materials are needed in order to make the sandal "rugged and robust", "lighter weight", provide "traction" and improve "ventilation and cushioning." In contrast, the lofted foam of the footwear of claims 1 and 42 provides at least some of these features using a single material.

As set forth in the Aguerre patent, a "plurality of recesses 120 are formed in the bottom of the midsole 110 for receiving pieces or sections of rubber or synthetic material which form the rugged outsole 112." Col 5, lines 19-22. Also, the sandal includes a vamp 104 that is bonded to midsole 110 and is constructed from PVC. See col. 6, lines 37-45. Hence, to construct the Aguerre sandal, at least three separate materials are required. Further, "[i]f additional cushioning and air circulation is desired when wearing the convertible slide 100, a fabric can be attached to the top surface 122 of the midsole 110 by a suitable adhesive well known in the art. The fabric can include a combination of materials ranging from synthetic-to-leather materials. In the preferred embodiment, a suitable fabric could include a foam material 126 adhered to a fabric backing incorporated within a mesh material 128." Col. 6, lines 15-22.

Importantly, Aguerre specifically teaches the use of a foam rubber for one of its materials, but only to provide cushioning, while relying upon three other materials to construct the rest of the sandal. As such, Aguerre directly teaches away from making the entire sandal from a foamed material because such a material would not provide the other benefits touted by Aguerre as being important (see above discussion). In short, Aguerre clearly teaches away from a base "formed as a first part molded from a first continuous piece of lofted foam material," instead favoring a base composed of three distinct sections made from different materials, none of which are intended to be made from a foamed material.

It is well established law that the teachings of one reference may not be combined with the teaching of a second reference when there is a specific teaching away. *See* M.P.E.P. §

2143.01; M.P.E.P. 2144.05; *Iron Grip Barbell Co., Inc. v. USA Sports, Inc.*, 392 F.3d 1317, 1322 (Fed. Cir. 2004) (holding presumption of obvious can be overcome if shown "[t]hat the prior art taught away from the claimed invention). Therefore, the Answer improperly combined Aguerre with Seidel to reject claims 1, 9, 12-16, 18-23, 26-27, and 40-42.

Finally, Appellant notes that no cite is made to any reference for the presented motivation to combine the disparate teachings of Seidel with Aguerre, especially regarding a lofted foam heel strap, such that the Appellant can only assume Official Notice is being relied upon for this proposition. Baldy, the Answer states that it would be "easier and cheaper" to manufacture footwear using this method. None of the cited references teach or suggest this, nor does the Answer provide any support for this statement. Furthermore, the Answer does not provide any evidence that making the Aguerre shoe from a lofted foam material would be easier and cheaper than the method taught by Aguerre. Indeed, due to the complicated shape of the Aguerre sandal, it appears that it may actually be more costly to make the Aguerre shoe from a single continuous piece of a lofted foam material. Should this apparent Official Notice be maintained, an express showing of documentary proof of the motivation is requested as set forth in M.P.E.P. §2144.03.

As to the second limitation which requires a frictional force at the contact between the inner portion of the strap section and the outer portion of the rear sole perimeter, the examiner asserts that although Aguerre fails to teach this limitation, "it would have been obvious to one of ordinary skill in the art at the time the invention was made to extend the strap of Aguerre '249 to the back of the footwear and be held fixed in place by the frictional force between the strap section and the base section at the contact between the inner portion of the strap section and the outer portion of the rear sole perimeter as taught by Albiniano '566 to better secure the strap to the back of the shoe so as to allow the shoe to be worn without the strap in different arrangement to give the wearer different design options." Answer, page 7.

This argument by the examiner fails to recognize that Aguerre specifically teaches away from such a frictional contact. More specifically, one of ordinary skill in the art would not be motivated to extend the strap of Aguerre back to the heel section to cause a friction engagement when the Aguerre references specifically teaches the use of a washer to permit

smooth pivoting of the strap. Indeed, the rear heel strap disclosed by Aguerre is described as being capable of being “freely rotated” between a first and second position. *See, e.g., id.*, Col. 7, lines 49-53; Col. 9, lines 29-34, and Col. 10, lines 48-50. In fact, in several embodiments, additional washers are added to ensure free rotation about the rotation point. As explained in Aguerre, “during rotation of the rear heel strap 202 about the rivet 244, it is common for the friction between the heel strap 202, the vamp 204 and the rivet 244 to interfere with smooth rotation. In order to facilitate smoother rotation of the rear heel strap 202 about the rivet 244, one of a first pair of nylon washer separators 246 is placed on the inside of the rear heel strap 202 and one of a second pair of nylon washer separators 248 is placed on the outside of the rear heel strap 202 as shown in FIG. 12.” *Id.*, Col 9, lines 20-29.

Because the heel strap of Aguerre is designed to freely rotate about its connection point, and to specifically minimize friction to ensure free rotation through use of washer separators, the combining of Aguerre with the teachings of Albiniano is improper and thus fails to present a prima facie case of obviousness. Rather, such a combination is clearly hindsight reconstruction of the cited art, which is clearly impermissible.

Hence, for the above reasons, a prima facie case of obviousness has not been established as to claims 1, 9, 12-16, 18-27 and 40-42. Appellant therefore respectfully requests withdrawal of this rejection.

B. Claims 24 and 25

Dependent claims 24 and 25 depend from claim 1 and relate to a footwear piece comprising a base section and a strap section, both respectively formed as a part molded from lofted foam material. The base section of the footwear piece comprises an upper and a sole. The sole further comprises a support base, wherein the support base includes a raised pattern extending throughout the surface where a foot contacts the support base.

Contrary to the examiner's position, the Lamstein patent fails to teach a "raised pattern extending throughout the surface where a foot contacts the support base." Instead, Lamstein teaches just the opposite by providing a smooth surface where the heel contacts the shoe base.

Further, Counsel disagrees with the assertion in the Answer which states that "Lamstein discloses a molded footwear with the support base including raised pattern extending throughout the surface inasmuch as that which is shown by the applicant in his Figures" (Answer, p. 6, lines 10-12). This interpretation of Lamstein is clearly incorrect. Lamstein expressly discloses a footwear piece that does not have a raised pattern where the heel contacts the shoe. FIG. 2. On the other hand, Appellant clearly claims a raised pattern throughout the surface where the foot contacts the base, including the heel. (Application, FIG. 3).

Hence, for this reason, a prima facie case of obviousness has not been established. Therefore, the Applicant traverses the rejection of claims 24 and 25, and respectfully request withdrawal of this rejection.

CONCLUSION

For at least these reasons, Appellant continues to believe that all pending claims are patentable.

Respectfully submitted,

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